

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 1-44 are pending in the application, with Claims 1, 12, 23, 34, 38, and 42 being the independent claims. The claims have been amended solely for grammatical reasons. No rejection has been made under any part of 35 U.S.C. §112; therefore, no amendment relating to patentability under this statutory section is needed. No change has been made to the scope of the claims. Specifically, the claims have not been amended to avoid or overcome the references of record. As discussed below, no such amendments are believed necessary.

Rejections Under 35 U.S.C. §103

All claims have been rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,031,294 to Geis *et al* in view of at least U.S. Patent No. 6,281,601 to Edelman *et al*. The several rejections based on these references, whether alone or in combination with additional references cited against claims 2, 3, 11, 13, 14, 22, 24, 25, 33, 35, 39, 43, and 44, are respectfully traversed.

The Geis '294 patent is commonly owned by the owner of the present application. Both the Geis '294 patent and the present application are assigned to Capstone Turbine Corporation. *See* Assignment of the Geis '294 patent recorded January 5, 1998, at Reel 008926, Frame 0766; and Assignment of the present application recorded May 15, 2002, at Reel 012901, Frame 0901. A copy of each recorded Assignment is attached for the Examiner's convenient reference.

Based on the foregoing, it is clear that the Geis '294 patent is not available as a reference under 35 U.S.C. §103(c), which states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Since Geis '294 is not available as a reference, and since each rejection is grounded principally on Geis '294, it is clear that all grounds of rejection are improper and should be withdrawn.

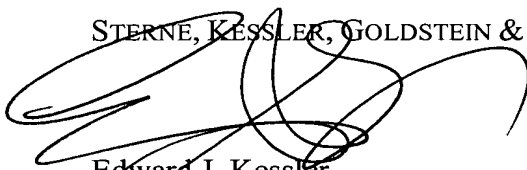
Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



Edward J. Kessler
Attorney for Applicants
Registration No. 25,688

Date: 1/23/04
1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600



UNITED STATES
PATENT AND
TRADEMARK OFFICE

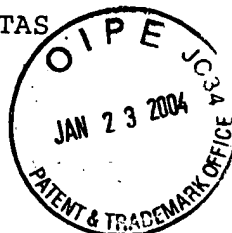
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Capstone Turbine 15751-403

JULY 19, 2002

IRELL & MANELLA LLP
RACHELE WITTWER
1800 AVENUE OF THE STARS
SUITE 900
LOS ANGELES, CA 90067

PTAS



Commissioner for Trademarks
Arlington, VA 22202-3513
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PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 05/15/2002

REEL/FRAME: 012901/0901
NUMBER OF PAGES: 3

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:

WACKNOV, JOEL

DOC DATE: 04/26/2002

ASSIGNOR:

GEIS, EVERETT R.

DOC DATE: 05/02/2002

ASSIGNEE:

CAPSTONE TURBINE CORPORATION
21211 NORDHOFF STREET
CHATSWORTH, CALIFORNIA 91311

SERIAL NUMBER: 10066349
PATENT NUMBER:

FILING DATE: 01/30/2002
ISSUE DATE:

KIMBERLY WHITE, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

MAY 1 2002

05-21-2002



102097475

Form PTO-1595

1-31-92

RECORDATION FC

PATENTS ONLY

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To the Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Joel Wacknov
Everett R. Geis

5115102

Additional name(s) of conveying party(ies) attached?

Yes ☐No ☒

2. Name and address of receiving party(ies):

Capstone Turbine Corporation

Street Address:

21211 Nordhoff Street

City / State:

Chatsworth, California 91311

Additional name(s) of receiving party(ies) attached?

Yes ☐No ☒

3. Nature of conveyance:

☒ Assignment☐ Security Agreement☐ Merger☐ Change of Name

Execution Dates:

April 26, 2002 and May 2,
2002, respectively

4. Application number(s) or Patent Number(s):

If this document is being filed together with a new application, the execution dates of the application are

A. Patent Application No.(s)

10/066,349

B. Patent No.(s)

Additional numbers attached?

☐ Yes☒ No

5. Name and address of party to whom correspondence concerning documents should be mailed:

Name: Rachele Wittwer
Address: Irell & Manella LLP
1800 Avenue of the Stars
Suite 900
City: Los Angeles
State: CA
Zip: 90067

6. Total no. of applications and patents involved: 1

7. Total fee (37 CFR 3.41): \$40.00

☒ Enclosed☐ Authorized to charge to deposit account

8. Deposit account number: 09-0946

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9. Statement and signature:

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document.

Robert Popa

Signature

May 6, 2002

Date

Total number pages including cover sheet, attachments, and documents: 3

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05/16/2002 SFELEKE1 00000075 10066349

02 FC:581

40.00 GP

153501-0403/P02458US
Serial No.: 10/066,349

ASSIGNMENT

This assignment is made by Joel Wacknov and Everett R. Geis, Assignors, to Capstone Microturbine Corporation, Assignee, having a place of business at 21211 Nordhoff Street, Chatsworth, California 91311.

WHEREAS, Assignors have invented a new and useful **DISTRIBUTED POWER SYSTEM**, for which an application for United States Letters Patent

☒ was filed on 1/30/02 and given Application No. 10/066,349
☐ is being filed herewith; and

WHEREAS, Assignors believe themselves to be the original, first and sole inventor of the invention disclosed and claimed in said application for Letters Patent; and

WHEREAS, Assignee desires to acquire by formal, recordable assignment the entire right, title and interest in and to said invention, said application and any Letters Patent that may be granted for said invention in the United States and throughout the world;

NOW, THEREFORE, in consideration of the sum of One Dollar (\$1.00) and of other good and valuable consideration the receipt and sufficiency of which are hereby acknowledged, Assignors hereby sell, assign and transfer to Assignee, the entire right, title and interest in and to said invention, said application and any Letters Patent that may be granted for said invention in the United States and throughout the world, including the right to file foreign applications directly in the name of the Assignee and to claim for any such foreign applications any priority rights in which such applications are entitled under international conventions, treaties, or otherwise.

Further, Assignors agree that, upon request and without further compensation, but at no expense to Assignors, their legal representatives and assigns will do all lawful acts, including the execution of papers and the giving of testimony, that may be necessary or desirable for obtaining, sustaining, reissuing, or enforcing Letters Patent in the United States and throughout the world for said invention, and for perfecting, recording, or maintaining the title of Assignee, its successors and assigns, to said invention, said application, and any Letters Patent granted for said invention in the United States and throughout the world.

Assignors represent and warrant that they have not granted and will not grant to others any rights inconsistent with the rights granted herein.

Assignors authorize and request the Commissioner of Patents and Trademarks of the United States and of all foreign countries to issue any Letters Patent granted for said invention, whether on said application or on any subsequently filed division, continuation, continuation-in-part or reissue application, to Assignee, its successors and assigns, as to the assignee of the entire interest in said invention.

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- 2 -

Patent Assignment Abstract of Title

**NOTE: Results display only for issued patents and published applications.
For pending or abandoned applications please consult USPTO staff.**

Total Assignments: 1

Patent #: 6031294 **Issue Dt:** 02/29/2000 **Application #:** 09003078 **Filing Dt:** 01/05/1998

Inventors: EVERETT R. GEIS, BRIAN W. PETICOLAS, JOEL B. WACKNOV

Title: TURBOGENERATOR/MOTOR CONTROLLER WITH ANCILLARY ENERGY STORAGE/DISCHARGE

Assignment: 1

Reel/Frame: 008926/0766

Recorded: 01/05/1998

Pages: 6

Conveyance: ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS).

Assignors: GEIS, EVERETT R.

Exec Dt: 12/11/1997

PETICOLAS, BRIAN W.

Exec Dt: 12/11/1997

WACKNOV, JOEL B.

Exec Dt: 12/11/1997

Assignee: CAPSTONE TURBINE CORPORATION

18700 OXNARD STREET

TARZANA, CALIFORNIA 91356

Correspondent: ALBERT J. MILLER

24441 HILLSHORE DRIVE

WESTPORT, CA 95488

Domestic rep: ALBERT J. MILLER

24441 HILLSHORE DRIVE

WESTPORT, CA 95488

Search Results as of: 1/7/2004 8:52:37 A.M.

If you have any comments or questions concerning the data displayed, contact OPR / Assignments at 703-308-9723
Web interface last modified: Oct. 5, 2002

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02-06-1998

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Conveying Party(ies)

☒ Mark if additional names of conveying parties attached

Name (line 1) Geis, Everett R.

Execution Date
 Month Day Year
12/11/97

Name (line 2) _____

Second Party

Name (line 1) Peticolas, Brian W.

Execution Date
 Month Day Year
12/11/97

Name (line 2) _____

Receiving Party

☐ Mark if additional names of receiving parties attached

Name (line 1) Capstone Turbine Corporation

☐ If document to be recorded is an assignment and the receiving party is not domiciled in the United States, an appointment of a domestic representative is attached. (Designation must be a separate document from Assignment.)

Name (line 2) _____

Address (line 1) 18700 Oxnard Street

Address (line 2) _____

Address (line 3) Tarzana

City

CA

State/Country

91356

Zip Code

Domestic Representative Name and Address

Enter for the first Receiving Party only.

Name Albert J. Miller

Address (line 1) 24441 Hillshore Drive

Address (line 2) Westport, CA 95488

Address (line 3) _____

Address (line 4) _____

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Patent and Trademark Office
PATENT

Conveying Party(ies)☐ Mark if additional names of conveying parties attached

Enter additional Conveying Parties

Name (line 1) Wacknov, Joel B.Execution Date
Month Day Year12111997

Name (line 2)

Name (line 1)

Execution Date
Month Day Year

Name (line 2)

Name (line 1)

Execution Date
Month Day Year

Name (line 2)

Receiving Party(ies)☐ Mark if additional names of receiving parties attached

Enter additional Receiving Party(ies)

Name (line 1)

Name (line 2)

Address (line 1)

Address (line 2)

Address (line 3)

City

State/Country

Zip Code

Name (line 1)

Name (line 2)

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Address (line 2)

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☐ If document to be recorded is an assignment and the receiving party is not domiciled in the United States, an appointment of a domestic representative is attached. (Designation must be a separate document from Assignment.)

Application Number(s) or Patent Number(s)☐ Mark if additional numbers attached

Enter either the Patent Application Number or the Patent Number (DO NOT ENTER BOTH numbers for the same property).

Patent Application Number(s)

Patent Number(s)

09/003,078		

PATENT
REF: 8926 FRAME: 0767

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Page 2

U.S. Department of Commerce
Patent and Trademark Office
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Correspondent Name and AddressArea Code and Telephone Number 707-964-1154Name Albert J. MillerAddress (line 1) 24441 Hillshore Drive

Address (line 2) _____

Address (line 3) _____

Address (line 4) Westport, CA 95488**Pages**

Enter the total number of pages of the attached conveyance document including any attachments.

3**Application Number(s) or Patent Number(s)**☐ Mark if additional numbers attached

Enter either the Patent Application Number or the Patent Number (DO NOT ENTER BOTH numbers for the same property).

Patent Application Number(s)

Patent Number(s)

If this document is being filed together with a new Patent Application, enter the date the patent application was signed by the first named executing inventor.Month Day Year
12 11 1997**Patent Cooperation Treaty (PCT)**Enter PCT application number
only if a U.S. Application Number
has not been assigned.

PCT	<u> </u>	PCT	<u> </u>	PCT	<u> </u>
PCT	<u> </u>	PCT	<u> </u>	PCT	<u> </u>

Number of Properties

Enter the total number of properties involved.

1**Fee Amount**Fee Amount for Properties Listed (37 CFR 3.41): \$ 40.00Method of Payment:
Deposit AccountEnclosed ☒ Deposit Account ☐

(Enter for payment by deposit account or if additional fees can be charged to the account.)

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Authorization to charge additional fees:

Yes ☐ No ☐**Statement and Signature**

To the best of my knowledge and belief, the foregoing information is true and correct and any attached copy is a true copy of the original document. Charges to deposit account are authorized, as indicated herein.

Albert J. Miller

Name of Person Signing

Albert J. Miller
Signature1-5-98

Date

PATENT
REF ID: A926 FRAME 0768

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Attorney Docket No. AM-9722

ASSIGNMENT OF PATENT APPLICATION

WHEREAS, Everett R. Geis of 28631 Chimney Rock Circle, Trabuco Canyon, CA 92679, Brian W. Peticolas of 545 Avenue B, Redondo Beach, CA 90277, and Joel B. Wacknov of 253 Canyon Crest Dr., Monrovia CA 91016, hereinafter referred to as "ASSIGNORS", are the joint inventors of the invention described and set forth in the below identified application for United States Letters Patent:

Title of Invention: **TURBOGENERATOR/MOTOR CONTROLLER WITH
ANCILLARY ENERGY STORAGE/DISCHARGE**

Date of Execution: December 11, 1997

WHEREAS, Capstone Turbine Corporation, a Delaware corporation, located at 18700 Oxnard Street, Tarzana, California 91356, hereinafter referred to as "ASSIGNEE", wants to acquire an interest in the invention and application and in any Letters Patent and Registrations which may be granted on the same;

NOW, THEREFORE, for good and valuable consideration, the receipt of which is hereby acknowledged by Assignors, Assignors have assigned, and by these presents do hereby assign to Assignee, all right, title and interest in and to the said invention and all future improvements thereon, and in and to any Letters Patent and Registrations which may hereafter be granted on the same in the United States and all countries throughout the world, and to claim the priority from the application as provided by the Paris Convention. The right, title and interest is to be held and enjoyed by Assignee and Assignee's successors and assigns as fully and exclusively as it would have been held and enjoyed by Assignors had this assignment not been made, for the full term of any Letters Patent and Registrations which may be granted thereon, or any division, renewal, continuation in whole or in part, substitution, conversion, reissue, prolongation or extension thereof.

Assignors further agrees that Assignors will, without charge to Assignee, but at Assignee's expense, (a) cooperate with Assignee in the prosecution of U. S. patent applications and foreign

PATENT
REF: 8926 FRAM: 0769

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counterparts on the invention and any improvements, (b) execute, verify, acknowledge and deliver such further papers, including patent applications and instruments of transfer, and (c) perform such other acts as Assignee lawfully may request to obtain or maintain Letters Patent and Registrations for the invention and improvements in any and all countries, and to vest title thereto in Assignee, or Assignee's successors and assigns.

IN TESTIMONY WHEREOF, Assignors has signed their names on the dates indicated.

Dated: 12/11/97

Everett R. Geis
Everett R. Geis

Dated: 12/11/97

Brian W. Peticolas
Brian W. Peticolas

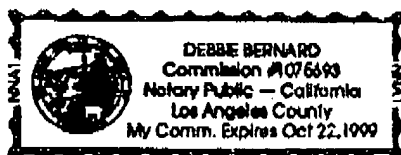
Dated: 12/11/97

Joel B. Wacknov
Joel B. Wacknov

STATE OF CALIFORNIA)
) ss.
COUNTY OF LOS ANGELES)

On Dec. 11, 1997 before me, Debbie Bernard, Notary Public, personally appeared ~~Everett R. Geis, Brian W. Peticolas and Joel B. Wacknov~~, personally known to me or proved to me on the basis of satisfactory evidence to be the persons whose names are subscribed to the within instrument and acknowledged to me that they executed the same in their authorized capacities, and that by their signatures on the instrument the persons, or the entity upon behalf of which the persons acted, executed the instrument.

WITNESS my hand and official seal.



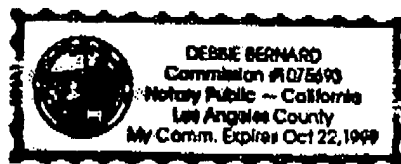
Debbie Bernard
Signature of Notary Public

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STATE OF CALIFORNIA)
) ss.
COUNTY OF LOS ANGELES)

On Dec 11, 1997 before me, Debbie Bernard, Notary Public, personally appeared Brian W. Peticolas, personally known to me or proved to me on the basis of satisfactory evidence to be the person whose name is subscribed to the within instrument and acknowledged to me that he executed the same in his authorized capacity, and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.

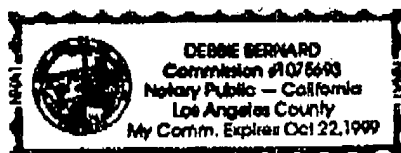


Debbie Bernard
Signature of Notary Public

STATE OF CALIFORNIA)
) ss.
COUNTY OF LOS ANGELES)

On Dec 11, 1997 before me, Debbie Bernard, Notary Public, personally appeared Joel B. Wacknov, personally known to me or proved to me on the basis of satisfactory evidence to be the person whose name is subscribed to the within instrument and acknowledged to me that he executed the same in his authorized capacity, and that by his signature on the instrument the person, or the entity upon behalf of which the person acted, executed the instrument.

WITNESS my hand and official seal.



Debbie Bernard
Signature of Notary Public

RECORDED: 01/05/1998

PATENT
RIEL : 8926 FRAMP: 0771